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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,342	10/22/2001	Guoqiang Wang	ENP-035	3219

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EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,342

Applicant(s)

WANG ET AL.

Examiner

Rebecca L Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

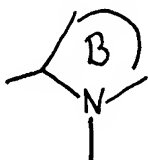
DETAILED ACTION

Claims 23-25 are currently pending in the instant application. Claims 1-22 were cancelled in applicants amendment filed 27 February 2003.

Election/Restrictions

The generic concept, inclusive of the elected species, as indicated for examination in Paper No. 4, mailed 25 November 2002 is that of the compound as found in claim 1 (now cancelled) wherein:

R₁, **R₂**, **A** and **E** are as found in claim 1,



is thiazolidine and

D is SO₂.

The remaining subject matter of claims 23-25 stands withdrawn, 37 CFR 1.142 (b), as being for non-elected inventions. The withdrawn subject matter of the claims is properly restricted as said subject matter differs materially in structure and element from the elected subject matter so as to be patentably distinct, i.e. a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Additionally, the fields of search are not co-extensive.

Accordingly, the claims are drawn to more than a single invention and restriction as has been required is proper, 37 CFR 1.142 (a).

Applicants have argued that the restriction practice employed by the Examiner, as applicable to species within a claimed genus, appears not to comport with the MPEP.

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However, this argument is not found persuasive because, it is pointed out, that the restriction requirement is made under 35 U.S.C. 121, which gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one-independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants argue to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. So, here we have claims which involve more than one independent or distinct inventions. Under 35 U.S.C. 121, the claims may be restricted and the examination limited to a restricted invention. There is no argument or evidence to the contrary. Accordingly, restriction as has been presented in this application is proper. Therefore, the requirement to restrict is repeated and made final.

Claim Objections

Newly added claims 23-25 are objected to as containing non-elected subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Newly added claims 23-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter not properly described in the application as filed are the variables "R3" and "R4" and their values (i.e. C1-C20 alkyl, C1-C10 hydrocarbon, aryl, substituted aryl, alkylaryl, substituted alkylaryl, heterocyclyl, and substituted heterocyclyl) or where R3 and R4 taken together with the carbon atoms to which they are attached form a cyclic moiety selected from the group consisting of: aryl and substituted aryl. No support was found for the above mentioned subject matter in the instant specification. The only substituents supported in the instant specification for ring B are found on page 5 and page 7 and only include lower alkyl, lower alkoxy, lower alkylthio, hydroxy, mercapto, cyano, carboxy, lower alkoxycarbonyl, lower alkylaminocarbonyl, amino, lower alkylamino, di(lower alkyl)amino, nitro, halo and haloalkyl, which are not the substituents as instantly claimed in claims 23-25.

Specification

The amendment filed 27 February 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The variables "R3" and "R4" and their values (i.e. C1-C20 alkyl, C1-C10 hydrocarbon, aryl, substituted aryl, alkylaryl, substituted alkylaryl, heterocyclyl, and substituted heterocyclyl) or where

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R3 and R4 taken together with the carbon atoms to which they are attached form a cyclic moiety selected from the group consisting of: aryl and substituted aryl are not supported by the original disclosure. Applicant's representative states that support for claim 23 is found on page 4, scheme II on page 17 and scheme III on page 19 of the instant application, however no support is found on these pages. Page 5 of the instant specification only provides support for 0-3 substituents on the ring B chosen from lower alkyl, lower alkoxy, lower alkylthio, hydroxy, mercapto, cyano, carboxy, lower alkoxycarbonyl, lower alkylaminocarbonyl, amino, lower alkylamino, di(lower alkyl)amino, nitro, halo and haloalkyl. Also, the representative subgenus on page 7 only provides support for substituents "R8" and "R9" which can "each be hydrogen, lower alkyl, lower alkoxy, lower alkylthio, phenyl, hydroxy, mercapto, cyano, carboxy, lower alkoxycarbonyl, lower alkylaminocarbonyl, amino, lower alkylamino, di(lower alkyl)amino, nitro, halo or haloalkyl."

Applicant is required to cancel the new matter in the reply to this Office Action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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